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09/742,438	12/22/2000	Leandros Kontogouris	BEU/HK/KONTOGOURIS	8890

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/742,438

Applicant(s)

KONTOGOURIS, LEANDROS

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-49 have been examined.

#### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The

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phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in

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affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is explicitly being utilized by claims 1, 2. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 3, 8-11, 21, 22, 26-29, 35, 36 are rejected under 35 U.S.C. 102(e) as being unpatentable over Auxier (6,379,251).

Claim 1, 21, 35: Auxier discloses a method, system for ensuring that a user acknowledges an advertisement in exchange for access to an electronic address, service, or content, comprising: a computing or communications device of said user, said computing or communications device being connected to a provider of said address, service, or content, over a data communications network (Fig. 1);

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software arranged to be loaded onto said computing or communications device and arranged to participate in presentation of an interactive banner advertisement to the user when said user indicates a desire to access said address, service, or content (col 3, lines 57-61; Fig. 3; col 2, lines 10-20),

wherein, upon presentation of the interactive banner advertisement, said user is permitted access to the address, service, or content only if the user submits an appropriate reply to the interactive banner advertisement (col 8, lines 60-65).

Claim 2: Auxier discloses a method as claimed in claim 1, and Auxier further discloses that said electronic address, service, or content is an Internet uniform resource locator (col 1, lines 33-35).

Claim 3, 22, 36: Auxier discloses a method as claimed in claim 1, and Auxier further discloses that said electronic address, service, or content is content provided by a server connected to the Internet (col 1, lines 10-15).

Claim 8, 26: Auxier discloses a method as claimed in claim 7, and Auxier further discloses that a provider of the electronic address, service, or content downloads said client software to the user's computing device when said user requests access to said electronic address, service, or content (Fig. 3; col 2, lines 10-20).

Claim 9, 27: Auxier discloses a method as claimed in claim 8. Auxier further discloses that said client software is resident on said user's computing device before said user requests access to said electronic address, service, or content (col 4, lines 43-53; col 2, lines 10-15). Auxier further discloses the reception of special code that allows banner advertisements to be interacted with (col 4, lines 43-53) and that the special code can be stored on the client computer

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(col 2, lines 10-15). Therefore, Auxier implies that the special code can reside on the client computer before future requests for the user will make.

Claim 10, 28: Auxier discloses a method as claimed in claim 8, and Auxier further discloses that said client software is resident on a server located at or that provides the electronic address, service, or content (Fig. 3; col 2, lines 9-11). Note that regardless of where the client software runs from, the client software is resident on the server before the client software is downloaded from the server to the client.

Claim 11, 29: Auxier discloses a method as claimed in claim 1, and Auxier further discloses that said client software connects said user's computing device to a server located at or that provides said electronic address, service, or content, and wherein said server carries out said steps of presenting said interactive banner advertisement and permitting access to said electronic address, service, or content (Fig. 3; col 2, lines 10-20).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 7, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Griffiths (6,286,045).

Claim 7, 25: Auxier discloses a method as claimed in claim 1.



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Auxier discloses an interactive banner advertisement and permitting access to said service only if the user submits an appropriate reply to the banner advertisement as disclosed in the independent claim.

Auxier does not explicitly disclose that said client software connects said user's computing device to a proxy server, and wherein said proxy server carries out said steps of presenting said interactive banner advertisement.

However, Griffiths discloses banner advertisements (col 3, lines 13-21). Griffiths further discloses that said client software connects said user's computing device to a proxy server, and wherein said proxy server carries out said steps of presenting said interactive banner advertisement (Fig. 1; Fig. 3; col 4, lines 17-29). Griffiths further discloses taking measures for more efficient delivery of advertising over a network (col 1, lines 9-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Griffiths utilization of proxy servers with banner advertisements to Auxier's banner advertisements delivered over a network. One would have been motivated to do this for more efficient deliver of advertising over a network.

4. Claims 4, 5, 6, 12-15, 19, 20, 23, 24, 30, 31, 32, 37, 38, 39, 42-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Slotznick (6,011,537).

Claim 42, 44, 46, 47: Auxier discloses a banner advertisement, comprising: promotional text arranged in a box on a display screen of a computing or communications device and presented to a user of the computing or communications device who requests access to an electronic address, service, or content over a network (Fig. 4; col 3, lines 57-61);

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and area associated with said box for permitting entry of a response to said text (col 8, lines 60-65; Fig. 4),

wherein said banner advertisement prevents access to said electronic address, service, or content unless said response to said text is entered by the user (col 8, lines 60-65; Fig. 4).

Auxier further discloses that said banner advertisement is in a multimedia format (col 2, lines 5-9).

Auxier does not explicitly disclose that the promotional text is presented when the user requests access to content over a network.

However, Slotznick disclose that the promotional text is presented when the user requests access to content over a network (col 4, lines 49-56).

Slotznick further discloses that said area includes a pop-up menu (col 3, lines 34-36).

Slotznick further discloses sounds and multimedia (col 1, lines 53-57; col 1, lines 61-64; col 2, lines 12-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's presenting the promotion when the user requests content to Auxier's game before the user is permitted to access the content. One would have been motivated to do this because some users may not want to request the primary information or content if they knew that had to see promotional information first.

Claim 4, 5, 6, 12, 14, 20, 23, 24, 30, 32, 37, 38, 39, 48, 49: Auxier discloses a method as claimed in claim 1 and Auxier and Slotznick disclose an advertisement as in claim 42.

Auxier discloses television and the Internet (col 1, lines 10-15; col 1, lines 17-21).

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Auxier does not explicitly disclose that said electronic address, service, or content provided by a broadcaster on an interactive digital television network.

Auxier does not explicitly disclose an cellular or wireless network.

However, Slotznick discloses that said electronic address, service, or content provided by a broadcaster on an interactive digital television network (col 5, lines 24-28; col 7, lines 35-42).

Slotznick further discloses a wireless network and a cellular network (col 18, lines 25-32).

Slotznick further discloses the utilization of cookies (col 15, lines 40-47).

Slotznick further discloses a plug-in to an Internet browser installed on said user's computing device (col 31, lines 53-55; col 32, lines 1-14).

Slotznick further discloses that said electronic address, service, or content is a subscription-based service (col 16, lines 18-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's interactive television, cellular, wireless network, and cookies to Auxier's Internet and television. One would have been motivated to do this because interactive television is an obvious device that combines the Internet and television and would appeal to many users and the Internet is obviously manifested on different types of network for the convenience of the user and cookies are a standard and convenient way to store information on a user's device. Furthermore, plug-ins are standard Internet software tools and a subscription service is a standard and convenient way for a user to receive information.

Claim 13, 31: Auxier and Slotznick disclose the method as claimed in claim 12.

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Auxier further discloses downloading software (col 2, lines 9-20) and that software is necessary before gaining access to said electronic address, service, content and that that software is retrieved (col 4, lines 45-50; Fig. 3).

Auxier does not explicitly disclose that the software is a plug-in or that the download occurs when the user requests access to the content.

However, Slotznick discloses a plug-in to an Internet browser installed on said user's computing device (col 31, lines 53-55; col 32, lines 1-14).

Slotznick further discloses downloading required software to the client when the client requests access to the electronic address, service, or content (col 12, lines 40-52).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's plug-in downloaded when the user requests content to Auxier's necessary software which is retrieved to the client device before accessing the content and Auxier's software which is downloaded to the client device. One would have been motivated to do this because a plug-in is a standard Internet software tool and downloading required software when a user requests access to content is a convenient time to download software to a client.

Claim 15, 19: Auxier and Slotznick disclose a method as claimed in claim 14.

Auxier further discloses targeting advertisements to the user (col 3, lines 10-13).

Auxier further discloses collecting user provided information (col 2, lines 39-42; col 7, lines 17-23).

Auxier does not explicitly disclose the steps of identifying said user and determining whether said user has a subscription to said service, and wherein said step of presenting said

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interactive banner advertisement is carried out if said user does not have a subscription to said service.

However, Slotznick discloses the steps of identifying said user and determining whether said user has a subscription to said service, and wherein said step of presenting said interactive banner advertisement is carried out if said user does not have a subscription to said service (col 16, lines 9-29).

Slotznick further discloses that said interactive banner advertisements are selected based on information stored on said user's computing device and information provided by said user (col 16, lines 9-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's different information depending on the type of user to Auxier's targeted user. One would have been motivated to do this because targeting a user implies sending that user different information depending upon who the user is.

Claim 43, 45: Auxier and Slotznick disclose an advertisement as claimed in claim 43.

Auxier further discloses that said electronic address, service, or content is content provided by a server connected to the Internet (col 1, lines 10-15).

Auxier further discloses a hyperlink to a website of said advertiser (col 1, lines 33-35).

5. Claim 16-18, 33, 34, 40, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Slotznick (6,011,537) in view of Eggleston (6,061,660).

Claim 16: Auxier discloses a method as claimed in claim 1.

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Auxier further discloses targeting a user and that a user can be a repeat user (col 3, lines 10-14; col 4, lines 45-54).

Auxier further discloses that the user can win (col 6, lines 25-30).

Auxier further discloses that the user can win prizes in the form of the merchants services (col 6, lines 25-30).

Auxier does not explicitly disclose tallying credits or a subscription service.

However, Slotznick discloses a subscribing user or paying user (col 16, lines 17-22).

Slotznick further discloses that presenting said interactive banner advertisement can be based on the status and history of the user including whether or not the user has a subscription to said service (col 16, lines 9-29). Slotznick further discloses that whether an ad is shown or not can be controlled (col 16, lines 20-25).

Eggleston discloses tallying credits so that a user can receive a prize (col 13, lines 50-67) including the services of a merchant (col 1, lines 33-35; col 13, lines 60-62) and that the credits are tallied in response to a correct answer (col 26, lines 53-58; col 7, lines 45-50) and that the user has an account with credits in it (col 16, lines 54-56).

Eggleston further discloses that a user can be awarded for watching advertising (col 1, lines 37-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's subscription service and Slotznick's showing different advertisements to a user based upon the user status and history and Eggleston's tallying of points won as a status about a user to Auxier's targeted user and receiving merchant services as a prize for correct answers. One would have been motivated to do this because a subscription service is

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an obvious merchant service and tallying prize totals allows tracking the user for more advanced targeting over the longer term.

Claim 17, 18, 33, 34, 40, 41: Auxier discloses a method as claimed in claim 1.

Auxier further discloses targeting a user and that a user can be a repeat user (col 3, lines 10-14; col 4, lines 45-54).

Auxier further discloses that the user can win (col 6, lines 25-30).

Auxier further discloses that the user can win prizes in the form of the merchants services (col 6, lines 25-30).

Auxier does not explicitly disclose tallying credits or a subscription service.

However, Slotznick discloses a subscribing user or paying user (col 16, lines 17-22).

Slotznick further discloses that presenting said interactive banner advertisement can be based on the status and history of the user including whether or not the user has a subscription to said service (col 16, lines 9-29). Slotznick further discloses that whether an ad is shown or not can be controlled (col 16, lines 20-25).

Eggleston discloses tallying credits so that a user can receive a prize (col 13, lines 50-67) including the services of a merchant (col 1, lines 33-35; col 13, lines 60-62) and that the credits are tallied in response to a correct answer (col 26, lines 53-58; col 7, lines 45-50) and that the user has an account with credits in it (col 16, lines 54-56).

Eggleston further discloses that a user can be awarded for watching advertising (col 1, lines 37-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Slotznick's subscription service and Eggleston's tallying of points

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won so that a user can receive a merchant service to Auxier's targeted user and receiving merchant services as a prize for correct answers. One would have been motivated to do this because a subscription service is an obvious merchant service and tallying prize totals allows tracking the user for more advanced targeting over the longer term.

### *Conclusion*

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Miles (6,102,406) discloses banner advertisements and requiring user actions before viewing content..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AD

1/6/04

  
JAMES W. MYHRE  
PRIMARY EXAMINER